

REMARKS

INTRODUCTION:

In accordance with the following, no claim has been added, amended or cancelled herein. Claims 1 –12 are pending and under consideration. Claims 1, 4, 8, 10 and 11 are independent claims.

Reconsideration of the claims based on the following remarks is respectfully requested.

REJECTIONS UNDER 35 USC § 103:

Claims 1-12 stands rejected under 35 U.S.C. 103(a) as being as unpatentable over U.S. Patent Application No. 2003/0037179 by Duncan ("Duncan"). The rejection is respectfully traversed for at least the following reasons.

The Office Action notes on page 3, item 5, that Duncan does not explicitly teach the "display of a dialogue window." However, in addition, Duncan fails to suggest or disclose at least the following features recited in independent claim 1:

"requesting an operating system supporting a 16 bit device control portion to display a 32 bit dialogue window for exchange of information between a user and a predetermined device and not a 16 bit dialog window;"

The Office Action asserts at page 3, item 4 that Duncan describes the above-recited features. Specifically, the Office Action asserts Duncan describes:

"a computer program product which as a result of...the request of an application or operating system...enables a 32-bit computer to use 16-bit device cards [and in other embodiments, is capable of 64-bit to 32-bit]."

Even assuming for the sake of argument that the above statement is accurate, Applicants assert that Duncan still fails to suggest all of the above-recited features. For example, the Office Action fails to explain how a 32-bit computer that uses 16-bit device cards may be used to suggest a 16-bit computer's display of a 32 bit dialogue window. In fact, the two approaches are altogether different, and even antithetical to each other, each posing unique technical challenges. Moreover, the Office Action fails to provide any reason at all as to why one skilled in the art at the time of the invention would have modified Duncan.

Accordingly, Applicants respectfully submit that amended independent claim 1 patentably distinguishes over Duncan, and should be allowable for at least the above-mentioned reasons. Since similar features recited by each of the independent claims 4, 8, 9 and 11, with potentially differing scope and breadth, are not taught or disclosed by the reference, the rejection should be withdrawn and claims 4, 8, 9 and 11 also allowed.

Further, Applicants respectfully submit that claims 2-3, 5-7 and 12, which variously depend from independent claims 1, 4 and 11, should be allowable for at least the same reasons as claims 1, 4 and 11, as well as for the additional features recited therein.

Asserted Reason to Modify is Insufficient

Applicants respectfully submit that the rejection fails to establish a prima facie case of obviousness. To establish a prima facie case of obviousness, there must be some suggestion or reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *MPEP* 2142. Further, there must be a reasonable expectation of success. *MPEP* 2143.02.

Here, no citation to the prior art has been offered as providing a suggestion or reason to modify Duncan, nor does the Office Action provide evidence demonstrating an implicit motivation to modify Duncan. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 127 SCt 1727, 167 LEd2d 705 (U.S. 2007), the U.S. Supreme Court held that in determining obviousness, it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed" *KSR*, slip op. 14, 82 USPQ2d at 1396. Further, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR* at 1396, quoting *In re Kahn*. The reasoning provided in the Office Action for modifying Duncan states:

"It would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to include a 32-bit display at the operating system level (of the 32-bit operating system) that is communicating with a 16-bit driver in order to allow a user to interact with the computer program product that is enabling the communication between the OS and driver."

Applicants assert, for at least the reasons discussed below, that the cited rationale for modifying Duncan is at best merely a conclusion and is insufficient to meet the standard articulated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* Applicants respectfully submit that this amounts to an improper hindsight reconstruction of the invention.

First, Applicants assert the modification cited in the Office Action would still not suggest all of the features recited in independent claim 1. The Office Action proposes modifying Duncan to “include a 32-bit display at the operating system level (of the 32-bit operating system) that is communicating with a 16-bit driver.” However, independent claim 1 recites “requesting an operating system supporting a 16 bit device control portion to display a 32 bit dialogue window.” Consequently, modifying Duncan to include a 32-bit display at the operating level of a 32-bit operating system still fails to suggest “an operating system supporting a 16 bit device control portion.”

Furthermore, Applicants respectfully assert that the Office Action fails to establish that Duncan is analogous art. For art to be analogous, it must be in the field of Applicants’ endeavor or reasonably pertinent to the problem to be solved. *MPEP 2141.01(a)(I)* The rejection fails to provide any evidence as to why Duncan may be considered as analogous to the present application. To the contrary, Applicants assert that Duncan is not in the same field of endeavor because Duncan is not reasonably pertinent to the problem that the present claims seek to address.

Duncan is directed to a method for managing hardware device driver tokens in upgraded computers without having to re-engineer the old device card (par. [0002]). Duncan’s objective is to allow a 32-bit computer to function robustly with a 16-bit driver card to avoid system crashes (par. [0012]). Duncan is simply not concerned with a dialogue window and in fact fails to even mention the term “dialog window” anywhere in the document. In contrast, the present application states at paragraphs [0004] and [0005]:

“Thus, in an environment in which the operating systems, such as WINDOWS 95, WINDOWS 98, WINDOWS NT, WINDOWS 2000, and WINDOWS XP, are selectively used, a 16 bit device driver and a 32 bit device driver are inconveniently prepared to perform the same purpose.

The present invention provides a method of displaying a device driver dialogue window of a device using a single device driver regardless of the type of an operating system.”

Consequently, the Office Action fails to establish how Duncan’s techniques for managing hardware device driver tokens in 32-bit computers are reasonably pertinent to the objective of providing a single device driver dialogue window regardless of an operating system used.

Still further, Duncan teaches away from the present application. Duncan is directed to a 32-bit computer having a 16-bit device driver cards (par. [0002]). As Applicants asserted above, Duncan fails to even mention device dialogue window. However, in the 32-bit environment of Duncan it would be typical to display a 32 bit dialogue window, as is provided in the control panel of Windows XP, for example. Duncan fails to suggest any solution to the contrary. In contrast, the present claims recite "requesting an operating system supporting a 16 bit device control portion to display a 32 bit dialogue window." Thus, the solution proposed in Duncan is completely incompatible with that of the present invention because Duncan, through its lack of suggestion to the contrary, describes a 32-bit dialog window displayed using a 32-bit operating system.

In light of the arguments presented here, Applicants assert one skilled in the art would not have had a reason to modify Duncan, and thus the rejection under 103(a) is improper.

REQUEST FOR INTERVIEW BEFORE NEXT OFFICE ACTION:

Applicants respectfully request the Examiner contact the undersigned attorney to discuss the pending claims before issuance of the next Office Action. Applicants believe that a thorough review of the pending claims will be helpful in furthering prosecution.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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